

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GRIGORY SADKHIN

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Appeal No. 1999-0028  
Application No. 08/513,610

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ON BRIEF

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Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of solely claims 12 and 16 through 19 (Paper No. 8). While the brief (page 3) indicates that an amendment after final is submitted herewith to cancel all pending claims not subject to appeal, in a telephone conversation with Pamela S. Bennett of the Board of Patent Appeals and Interferences on March 22, 1999, counsel for appellant indicated that the referenced amendment had not been filed. Therefore, the only claims before us on appeal

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are claims 12 and 16 through 19, and the examiner should take appropriate action relative to the unappealed claims.

Appellant's invention pertains to a method for diagnosing a patient. A basic understanding of the invention can be derived from a reading of exemplary claim 12, a copy of which appears in the APPENDIX to the brief (Paper No. 12).

As evidence of obviousness, the examiner has applied the documents listed below:

McMahon et al 1983 (McMahon)	4,394,074	Jul. 19,
Sklar et al 1992 (Sklar)	5,098,426	Mar. 24,

The following rejections are before us for review.

Claims 12 and 16 through 19 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a disclosure which lacks enablement for treatment steps.

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Claims 12 and 16 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over McMahon in view of Sklar.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 13), while the complete statement of appellants' argument can be found in the brief (Paper No. 12).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,<sup>1</sup> and the respective viewpoints of appellant and the examiner.

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<sup>1</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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As a consequence of our review, we make the determinations which follow.

The enablement rejection

We do not sustain the rejection of claims 12 and 16 through 19 under 35 U.S.C. § 112, first paragraph, as being based upon a disclosure which lacks enablement for treatment steps.

Appellant's disclosure clearly encompasses diagnosis and treatment. However, the claims before us on appeal are expressly drawn to a method for diagnosing a patient, with no mention of any treatment. Thus, we determine that the examiner's enablement concerns regarding treatment in rejecting claims 12 and 16 through 19 are unfounded. It is for this reason that the enablement rejection cannot be sustained.

The obviousness rejection

We do not sustain the rejection of claims 12 and 16 through 19 under 35 U.S.C. § 103 as being unpatentable over McMahon in view of Sklar.

Independent method claim 12 requires, inter alia, the generation of an electrical signal encoding patterns in an iris, and the comparing of pattern data in that signal with previously stored pattern data to derive diagnostic information.

Appellant points out that the "customary procedure" is for a comparison to be made mentally by a iridology practitioner and since neither reference discloses or suggests comparing pattern data in an electrical signal with previously stored pattern data to derive diagnostic information, it would not have been obvious to implement the diagnostic procedure automatically (brief, page 6). Consistent with appellant's point of view, the difficulty we have with the examiner's rejection is that, absent appellant's own teaching, the

combined McMahon and Sklar teachings would not have been suggestive of the diagnosis method now claimed. McMahon (column 1, lines 38 through 42, column 2, lines 40 through 44, and column 4, lines 3 through 8) uses pictures for diagnostic review, while the diagnostic aspect of the laser surgery teaching of Sklar (column 22, lines 1 through 18) is achieved by viewing displayed images (Fig. 2). Thus, notwithstanding the circumstance that appellant may be now doing automatically what was previously done manually, the evidence before us simply would not have been suggestive of the content of method claim 12, in particular. The rejection of appellant's claims 12 and 16 through 19 cannot therefore be sustained.

REMAND TO THE EXAMINER

We remand this application to the examiner to consider the patentability of the claimed method under 35 U.S.C. § 103(a) taking into account the customary diagnostic comparison procedure manually carried out by an iridology practitioner<sup>2</sup>

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<sup>2</sup> See the background of the invention section of  
(continued...)

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in conjunction with any similar known comparison procedure that may be uncovered by the examiner in searching the respective fields of criminal investigation and security practice wherein electrical signals encoding fingerprints, palm prints, eye images, and face prints may have been electronically compared with stored data.

In summary, this panel of the board has:

not sustained the rejection of claims 12 and 16 through 19 under 35 U.S.C. § 112, first paragraph, as being based upon a disclosure which lacks enablement; and

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<sup>2</sup>(...continued)  
appellant's specification (page 1) and, in particular, the content of the booklet "Iridology Simplified" referenced therein (copy in application file).

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not sustained the rejection of claims 12 and 16 through  
19 under 35 U.S.C. § 103 as being unpatentable over McMahon  
in view of Sklar.

We have also remanded the application to the examiner.

The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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